

REMARKS

This paper is presented in response to the non-final official action of July 9, 2008, wherein (a) claims 1-3, 5, 7-13, 15-18, 20-33, 35, 44-46, 51, 52, 60-65 and 71-75 were pending; (b) claims 25-30 and 71 were rejected under 35 U.S.C. § 101; (c) claims 2, 3, 25-30 and 71 were rejected under 35 U.S.C. § 112, 2nd paragraph for indefiniteness; (d) claims 1, 5, 7-13, 15-18, 20-24, 31-33, 35, 44-46, 51, 52, 60-65, and 72-75 were allowed; and (e) claims 2, 3, 25-30 and 71 were objected to based on the rejections under (b) and (c) but indicated to be allowable if rewritten to overcome these rejections and include all of the limitations of the base claim and any intervening claims.

This paper is timely filed, as it is accompanied by a petition for automatic extension of time to file in the third month, and the requisite extension fee.

Claim Rejections Under 35 U.S.C. § 101

The office action rejected claims 25-30 and 71 because, per the examiner, these claims were directed to overlapping statutory classes, and because these claims did not set forth sufficient steps. Applicant traverses.

Applicant has amended claim 25 to more expressly recite a method of using the measuring device of claim 1 to perform a chemical analysis, where the method includes using that measuring device for qualitatively and/or quantitatively determining the presence of one or more components, selected from the group consisting of saccharides, urea, creatinine, triglycerides, carbon dioxide, protein, alcohols and/or phosphoric acid esters, in nonaqueous or aqueous systems. Claim 25 is a method claim that properly sets forth the step of the method, namely using the measuring device recited in claim 1 for determining qualitatively and/or quantitatively the presence of one or more components.

The amendment obviates the § 101 rejection. It is fully acceptable, for example, to provide a claim in one statutory class that references another claim in a different statutory class. The former merely presides as a dependent claim of the latter. MPEP 608.01(n) instructs that the test to determine whether a claim is in a proper dependent claim form is to determine whether that claim “shall include every limitation of the claim from which it depends...or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.” Applying this test, claim 25 is certainly a proper dependent claim from claim 1 – every recitation in claim 1 is included in claim 25. That claim

25 is a method claim and claim 1 is an apparatus claim is of no import to the propriety of these claims or to whether they are in the proper statutory class. "The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper." MPEP 608.01(n). MPEP 608.01(n), in fact, provides numerous examples where claims of one statutory class reference claims of another statutory class.

Claim Rejections Under 35 U.S.C. § 112, ¶2

Claims 2 and 3 have been amended to correct the antecedent basis for the "the evaluation unit."

As noted above, claim 25 has been amended to recite a method of using the measuring device of claim 1 to perform a chemical analysis, including "using that measuring device for qualitatively and/or quantitatively determining the presence of one or more components, selected from the group consisting of saccharides, urea, creatinine, triglycerides, carbon dioxide, protein, alcohols and/or phosphoric acid esters, in nonaqueous or aqueous systems." It is respectfully submitted that the amendment obviates the § 112, ¶2 rejection. As noted above, the claim does not recite both an apparatus and a process, but rather is properly directed to a process that uses an apparatus.

Ex parte Lyell (17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990)) – cited by the examiner – is distinguishable on the facts. The claim at issue in *Lyell* was explicitly directed to a "tool in the form of a workstand and method for using same." The Board determined that the claim purported to be both an apparatus claim and a process claim, and therefore was ambiguous and impermissible under 35 U.S.C. § 112, ¶2. Applicant's claim 25, however, is written solely as a method claim. The reference to the apparatus of claim 1 merely attempts to use "one statutory class of invention [to] define or fingerprint another statutory class" – a claim strategy that the Board confirmed to be acceptable in *Lyell*. *Ex parte Lyell*, 17 USPQ2d 1548, 1552.

The rejection of claims 25-30 and 71 are traversed.

Furthermore, while the office action has not rejected method claim 46, applicant has clarified method claim 46 by amendment above, and in furtherance of the above remarks. Method claims 31 and 32 were allowed, as was claim 46. But applicant has not proposed amending those claims.

As a result of the foregoing, pending claims 1-3, 5, 7-13, 15-18, 20-33, 35, 44-46, 51, 52, 60-65 and 71-75 are believed to be allowable. This application is in condition for allowance and an early indication of the same is respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, he is urged to telephone the undersigned attorney at the indicated number.

Dated: January 8, 2009

Respectfully submitted,

By 

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